

REMARKS

I. Status Summary

Claims 1-43 and 105-110 are pending and have been examined by the United States Patent and Trademark Office (hereinafter "the Patent Office") in a Non-Final Official Action dated June 23, 2008 (hereinafter "the Non-Final Official Action").

Claims 16, 23, 106, and 107 have been rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-43, 105-107, and 110 have been rejected under 35 U.S.C. § 103(a) upon the contention that the claims are obvious over U.S. Patent No. 6,281,189 to Heimann et al. (hereinafter "Heimann") in view of U.S. Patent Application Publication No. 2003/0213747 of Carbonell et al. (hereinafter "Carbonell"). Claims 1-19, 21-28, 33-43, 105, and 110 have also been rejected under this section over U.S. Patent No. 5,143,639 to Krawack (hereinafter "Krawack") in view of Carbonell. Claims 20 and 29-32 have also been rejected under this section over Krawack in view of Carbonell and further in view of Heimann.

Claims 1-19, 21-28, 33-43, and 105-110 have also been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-17 of co-pending U.S. Patent Application Serial No. 11/248,782 in view of Carbonell.

Claim 43 has been cancelled without prejudice.

Claims 16 and 106-108 have been amended. The amendments to claims 16, 106, and 107 are limited to replacing the term "butyl carbitol" with the phrase "diethylene glycol monobutyl ether". Since butyl carbitol is diethylene glycol monobutyl ether, no new matter has been added by the amendments to claims 16, 106, and 107. The amendments to claim 108 are designed to convert dependent claim 108 into an independent claim that includes all of the elements of the main claim from which claim 108 ultimately depended (i.e., claim 1) as well as the elements of intervening claim 105. Support for the amendment can be found throughout the specification as filed, including at page 18, line 16, through page 19, line 4. Additional support can be found in claims 1 and 105, the claims from which claim 108 had depended. Thus, no new matter has been added by the amendment to claim 108.

Reconsideration of the application as amended and in light of the remarks set forth hereinbelow is respectfully requested.

II. Responses to the Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 16, 23, 106, and 107 have been rejected under 35 U.S.C. § 112, second paragraph. According to the Patent Office, the recitations of "butyl carbitol" in claims 16, 106, and 107 is improper because "butyl carbitol" is a tradename, and it is unclear what is meant by "(ether, ester)" in claim 23.

With respect to the rejection of claims 16, 106, and 107, applicants have amended these claims to replace the recitations of "butyl carbitol" with "diethylene glycol monobutyl ether", which is the chemical name for butyl carbitol. As such, applicants respectfully submit that the rejection of claims 16, 106, and 107 has been addressed.

Turning now to the rejection of claim 23, applicants respectfully submit that "polyoxyethylene (20) castor oil (ether, ester)" is a non-ionic surfactant. It is referenced in various U.S. and PCT Applications including, but not limited to U.S. Patent No. 4,496,473 (see Table in column 6; POE (20) castor oil (ether, ester)); U.S. Patent No. 5,468,502 (see Table 1 in column 3); PCT/US01/40825 (see Table 1 on page 19); and PCT/US2007/007517 (see page 18, paragraph [0076]). As such, applicants respectfully submit that one of ordinary skill in the art would understand what is meant by "(ether, ester)", and respectfully request that the Patent Office withdraw the instant rejection of claim 23.

Summarily, applicants respectfully submit that the instant rejections of claims 16, 23, 106, and 107 under 35 U.S.C. § 112, second paragraph have been addressed, and respectfully request that they be withdrawn at this time.

III. Responses to the Obviousness Rejections

Claims 1-43, 105-107, and 110 have been rejected under 35 U.S.C. § 103(a) upon the contention that the claims are obvious over Heimann in view of Carbonell. Claims 1-19, 21-28, 33-43, 105, and 110 have also been rejected under this section

over Krawack in view of Carbonell. Claims 20 and 29-32 have also been rejected under this section over Krawack in view of Carbonell and further in view of Heimann.

After careful consideration of the rejections and the Patent Office's bases therefor, applicants respectfully traverse the rejections and submit the following remarks.

III.A. Response to the Rejection over Heimann in view of Carbonell

Claims 1-43, 105-107, and 110 have been rejected under 35 U.S.C. § 103(a) over Heimann in view of Carbonell. According to the Patent Office, Heimann teaches a composition containing at least one soybean oil-derived compound and at least one member chosen from the group of drying agents, co-solvents, and additives. The Patent Office acknowledges that Heimann does not teach the use of a benzoic acid ester. The Patent Office contends, however, that these deficiencies are cured by Carbonell, which is asserted to teach environmentally friendly solvents comprising GRAS solvents such as benzoic acid ester solvents. The Patent Office asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a benzoic acid ester solvent in the cleaning composition taught by Heimann because Carbonell teach the use of such solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents, and further that Heimann teaches the use of various co-solvents which would encompass benzoic acid ester solvents. Particularly, the Patent Office asserts on page 12 of the Non-Final Official Action that "Heimann, which is the primary reference, teaches that cosolvents are used in the compositions in amounts from 1 to 30% by weight". The Patent Office further asserts that "the cosolvents taught by Heimann are open to a wide variety of cosolvents and the selection of a particular cosolvent is not critical to the composition taught by Heimann" (see Non-Final Official Action at page 13). Thus, the Patent Office contends that a benzoic acid ester is a cosolvent as that term is used in Heimann and the instant application.

Applicants respectfully disagree. Applicants respectfully submit that the Patent Office continues to misinterpret the meaning of the term "cosolvent" in its assertion that

a benzoic acid ester solvent is a “cosolvent” as that term is used in the instant application. The instant application defines “cosolvent” to be “any substance, which upon addition to a composition increases the solubility of the composition in a particular solvent, such as water” (see Specification at page 16, lines 9-11; emphasis added).

Similarly, Heimann teaches that:

The co-solvent can comprise at least one member selected from the group consisting of water, soybean oil, hydrocarbon glycols, mixtures thereof, among others. The co-solvent can also comprise at least one propellant that is used for pressurized dispensing of the composition.

Heimann at col. 2, lines 13-17. The term “co-solvent” is also employed in context at col. 1, lines 51-53, which state “The composition can also include at least one co-solvent for the soybean oil derived compound and/or the drying agent” (emphasis added).

Therefore, it is clear from the disclosure of Heimann that the term “co-solvent” is employed in Heimann in the same way that it is employed in the instant specification: as a substance that increases the solubility of the composition in a particular solvent. Thus, applicants respectfully submit that when one of ordinary skill in the art considers Heimann in its entirety, it is clear that the term “co-solvent” is not synonymous with “another solvent” as asserted by the Patent Office.

Additionally, applicants respectfully submit that the Patent Office is applying an improper standard in asserting that “the cosolvent as described in Heimann will be given its broadest reasonable interpretation which would be an additional solvent enhancing the cleaning ability of the first solvent” (see Non-Final Official Action at page 13). Applicants respectfully submit that the term “co-solvent” in the Heimann patent must be interpreted consistent with how the term is used in Heimann. Applicants respectfully submit that there is no basis whatsoever for the Patent Office to conclude that “cosolvent” is “an additional solvent enhancing the cleaning ability of the first solvent”. Rather, it is clear that the Patent Office has gone outside of the Heimann patent’s teaching to derive this definition, and this is improper.

Summarily, applicants respectfully but urgently submit that contrary to the Patent Office’s assertion, the term “cosolvent” as that term is used in Heimann would not include a benzoic acid ester. Benzoic acid esters like other aromatic esters would not increase the solubility of methyl soyate in aqueous solution as would the “water,

soybean oil, hydrocarbon glycols, [and] mixtures thereof" disclosed in Heimann. As such, applicants respectfully submit that the Patent Office's assertion that "co-solvent" would equate to "additional solvent" is clearly and insupportably erroneous.

As a result, applicants respectfully submit that the Patent Office has not established that one of ordinary skill in the art would have added a benzoic acid ester to the composition disclosed in Heimann, and thus has not presented a *prima facie* case of obviousness of claim 1 over Heimann in view of Carbonell.

Claims 2-43 and 105-107 all depend directly or indirectly from claim 1, and thus are also believed to be distinguished over the cited combination. Claim 43 has been canceled, and thus the instant rejection is moot as to claim 43. As such, applicants respectfully request that the instant rejection of claims 1-42 and 105-107 be withdrawn at this time.

Turning now to claim 110, applicants respectfully submit that the Patent Office has provided no discussion regarding how Heimann in view of Carbonell would suggest the subject matter of this claim. Rather, the Patent Office merely asserts that "the teachings of Heimann et al in combination with Carbonell et al would suggest compositions having the same pH, flash point, and other characteristics of the composition as recited by the instant claims because Heimann et al in combination with Carbonell et al suggest compositions containing the same components in the same proportions as recited by the instant claims" (see Non-Final Official Action at page 7). Applicants respectfully submit that there is no disclosure whatsoever in either Heimann or Carbonell of compositions that are at least as efficient as diesel fuel for removing petroleum residues from substrates, which is an element of claim 110.

Therefore, applicants respectfully but urgently submit that Heimann in view of Carbonell does not support a rejection of claim 110 under 35 U.S.C. § 103(a). As a result, applicants respectfully request that the instant rejection of claim 110 also be withdrawn at this time.

III.B. Response to the Rejection over Krawack in view of Carbonell

Claims 1-19, 21-28, and 33-43 have been rejected under 35 U.S.C. § 103(a) over Krawack in view of Carbonell. According to the Patent Office, Krawack teaches compositions for removing inks and the like from printing machines. These compositions are asserted to contain a mixture of 50-100% by weight of a C₁-C₅ alkyl ester of an aliphatic C₈-C₂₂ monocarboxylic acid or a mixture of such esters, 0-50% by weight of vegetable oil, 0-10% by weight of a surfactant, and a corrosion inhibitor in an amount of up to 2% by weight.

While the Patent Office concedes that Krawack does not teach the use of a benzoic acid ester, the Patent Office asserts that this deficiency is cured by Carbonell. The Patent Office thus asserts that it would have been *prima facie* obvious to one of ordinary skill in the art to have used a benzoic acid ester in the cleaning composition taught by Krawack because Carbonell teaches the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents.

Applicants strongly disagree. Particularly, applicants respectfully traverse the Patent Office's assertion that it is appropriate under Kerkhoven to define the "purpose" of Krawack and of Carbonell as simply "residue cleaning compositions". Rather, applicants submit that as acknowledged by the Patent Office, the "purpose" of Krawack is dissolving inks and the like. The purpose of Carbonell, on the other hand, is dissolving petroleum products. Applicants strongly urge that one of ordinary skill in the art would not look to Carbonell to find solvents that would improve the cleaning of inks and the like since inks and petroleum products are not chemically similar.

Thus, and directly contrary to the Patent Office's assertion, Carbonell does not teach the use of solvents such as benzoic acid esters in similar cleaning compositions. As a result, applicants respectfully submit that the Patent Office has not presented a *prima facie* case of obviousness of claim 1 or of claim 110, and request that the Patent Office reconsider its position with respect thereto in light of applicants' remarks presented herein. Claims 2-19, 21-28, 33-43, and 105 all depend directly or indirectly from claim 1, and thus are also believed to be distinguished over Krawack in view of

Carbonell. Claim 43 has been canceled, and thus the instant rejection is moot as to this claim.

Accordingly, applicants respectfully request that the rejection of claims 1-19, 21-28, 33-42, 105, and 110 under 35 U.S.C. § 103(a) over Krawack in view of Carbonell be withdrawn at this time.

III.C. Response to the Rejection over Krawack in view of Carbonell
and further in view of Heimann

Claims 20 and 29-32 have been rejected under 35 U.S.C. § 103(a) over the combination of Krawack, Carbonell, and Heimann. According to the Patent Office, it would have been *prima facie* obvious to use d-limonene as a fragrance in the composition taught by Krawack because Heimann taught the use of d-limonene as an odorant in a similar cleaning composition, and further because odorants such as d-limonene are notoriously well known as suitable for use in cleaning compositions and desirable for such use.

Applicants respectfully submit that claims 20 and 29-32 all depend directly from claim 1, and thus include all the limitations of claim 1. Applicants respectfully submit that the comments presented hereinabove with respect to the rejections of claim 1 over the combination of Heimann and Carbonell and Krawack and Carbonell are equally applicable and persuasive here. Thus, applicants respectfully submit that since the Patent Office has failed to establish a *prima facie* case of obviousness of claim 1 over these combinations, the Patent Office has also failed to establish a *prima facie* case of obviousness of claims 20 and 29-32 since claims 20 and 29-32 all depend from claim 1.

Accordingly, applicants respectfully submit that claims 20 and 29-32 are distinguished over the combination of Krawack, Carbonell, and Heimann, and further respectfully request that the rejection under 35 U.S.C. § 103(a) over this combination be withdrawn at this time.

III.D. Evidence of Unexpectedly Superior Results

Assuming *arguendo* that the Patent Office has established a *prima facie* case of obviousness of the present claims over one or more of the combinations presented in the Non-Final Official Action, applicants respectfully submit the following additional remarks. It is axiomatic that a *prima facie* case of obviousness can be rebutted by evidence of unexpectedly superior results. Applicants respectfully submit that as shown in the attached DECLARATION OF ROBERT E. TROXLER, PH.D. PURSUANT TO 37 C.F.R. §1.132 (hereinafter “the Troxler Declaration), the presently claimed compositions are vastly superior to compositions consisting of an aliphatic ester alone (e.g., methyl soyate) at dissolving asphalt. Additionally, the combination of an aliphatic ester and an aromatic ester as claimed in the instant application provides much better than additive results vis-à-vis an aliphatic ester and an aromatic ester individually (see Points 8 and 9 of the Troxler Declaration).

Therefore, applicants respectfully submit that even if the Patent Office has presented a *prima facie* case of obviousness of the pending claims over one or more of Krawack, Carbonell, and Heimann, the *prima facie* case has been indisputably rebutted by the data presented in the Troxler Declaration.

Therefore, applicants respectfully request that the instant rejections of claims 1-43, 105-107, and 110 be withdrawn at this time. Claim 43 has been canceled, and thus the instant rejections are believed to be moot as to this claim. Accordingly, applicants urge that claims 1-42 and 105-110 are now in condition for allowance, and respectfully solicit a Notice of Allowance to that effect.

IV. Response to the Provisional Double Patenting Rejection

Claims 1-19, 21-28, 33-43, and 105-110 have been provisionally rejected under the judicially-created doctrine of non-statutory obviousness-type double patenting over claims 1-17 of co-pending application serial number 11/248,782 in view of Carbonell. Applicants respectfully submit, however, that the instant application has an earlier filing date (March 2, 2004) than the cited co-pending application (priority to October 12, 2004).

Accordingly, applicants respectfully submit that the provisional rejection is properly applicable to co-pending application serial number 11/248,782 and not to the instant application.

Furthermore, since the instant rejection is the only rejection applied to claims 108 and 109, these claims should be in condition for allowance at this time. With the allowance of claims 108 and 109, the instant provisional obviousness-type double patenting rejections should also be moot as to the instant application.

CONCLUSIONS

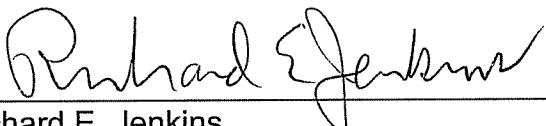
Should there be any minor issues outstanding in this matter, the Examiner is respectfully requested to telephone the undersigned attorney. Early passage of the subject application to issue is earnestly solicited.

DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayments associated with the filing of this correspondence to Deposit Account Number **50-0426**.

Respectfully submitted,
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REJ/CPP/gwc

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